

REMARKS

The application was filed with Claims 1-43. Claims 2-13 and 15-43 remain in the application. New Claim 44 is presented for consideration. Claims 2-13, 15-26 and 30-43 stand provisionally rejected on the grounds of non-statutory obvious-type double patenting as being unpatentable over Claims 1-33 of copending Application No. 10/630 378. Claims 3-7, 13, 18-19, 26-28, 32-33, 38-41 and 43 stand rejected under 35 USC §102. Claims 2, 8-12, 15-17, 20-25, 29-31, 34-37 and 42 stand rejected under 35 USC §103. These rejections are respectfully traversed. In view of the foregoing, and the following remarks, withdrawal of the rejections of Claims 2-13 and 15-43, and reconsideration of the claims, is respectfully requested.

As disclosed, the material of the container, and the container itself, are formulated to withstand all temperatures within the particular range as now claimed in Claim 40, i.e. from -50°C to +120°C, and not only within a limited range falling within the claimed range. A container and material capable of withstanding this range of temperatures is not disclosed by the prior art. Further, a container capable of withstanding the claimed temperature range is counterintuitive in combination with the other elements of the invention as claimed in Claim 40. It is not disclosed, nor would it have been obvious, to provide a container stable throughout the stated temperature range, and also transparent, fluid tight, and dimensionally stable throughout the stated temperature range. Only with this combination of features is it possible to use the container for cold food, for food at room temperature, and also for heated food, wherein the container will simultaneously be transparent, fluid tight and dimensionally stable. Throughout the prior art, the emphasis is on containers that are generally only used for food within a narrow temperature range, i.e. either low temperatures for

frozen foods such as ice cream, or high temperatures such as coffee or tea, and not both.

In Benson '318, for instance, a paper cup is disclosed as being transparent. For a paper material to be transparent, it would by necessity be so thin as to negate its ability to withstand the extremes of temperature required by the claims. The expansion of freezing food would likely destroy the container. Further, the transparency is cited by Benson as enabling the user to observe an edge at the seam, to determine if a cup was previously used. This indicates that the seam is not fluid tight, as required by the claims. If Benson's device were fluid tight, there would be no indicator of prior use to be observed through a transparent material.

Double Patenting Rejection

Claims 2-13, 15-26 and 30-43 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 10/630,378. This rejection is respectfully traversed, pending allowance of the claims in the '378 application.

Rejections Under 35 USC §102

Claims 3-7, 13, 18-19, 26-28, 32-33, 38-41 and 43 stand rejected under 35 USC §102(b) as being anticipated by US Patent 1 654 318 to Benson "with evidence provided by Barbieri (USPN 2,416,813)." These rejections are respectfully traversed.

Applicant does not understand the use of multiple references in the above-cited rejection under 35 USC §102. Either the claims are anticipated by Benson '318 above, or they are not. Applicant asserts that the claims are not anticipated thereby.

It is well established that for a claim to be anticipated by a reference, each and every element of the claim must be found in that reference. Benson '318 discloses a paper

drinking cup that is waterproofed, and particularly a paper drinking cup "of the type wherein the bottom closure is a separate piece sealed to the wall of the cup."

Regarding the rejection of Claim 40, the Examiner has asserted that "the container [of Benson] is stable from -50°C to +120°C, since the container is formed of paper stock for the purpose of forming a drinking cup." There is no support for this assertion to be found in Benson '318.

Benson '318 does not disclose any operating temperature range for the paper drinking cup, but only cites use of the cups for a "soda fountain" in column 1, lines 49-55. It is believed counterintuitive that a paper drinking cup, especially such a cup directed to use at a soda fountain, would be constructed to withstand temperatures exceeding that of boiling water. With regard to Examiner's "evidence" as presented by Barbieri '813, that paper cups are used for "frozen and boiling beverages," Barbieri '813 does not teach this. First, Barbieri '813 does not cite "boiling beverages," as asserted, but only "hot or cold liquids or substances, such for example as coffee, ice cream, cottage cheese, etc." in column 1, lines 5-7. Even if Benson or Barbieri cited boiling liquid, such would still not teach the claim limitation of "from -50°C to 120°C," inasmuch as water boils at 100°C, well short of the claimed stability extending to 120°C. Further, ice cream, the only frozen commodity disclosed, is generally stored or served at a temperature in the -20°C to -12°C range, well above the claimed -50°C lower limit. Accordingly, even if the teachings of both references were combined, the combination would not teach the claimed invention.

Further, it is not appropriate to use the disclosure of Barbieri '813 as "evidence" of the teaching of Benson '318. Benson '318 teaches a single layer paper drinking cup, while Barbieri '813 discloses a multilayer construction, the layers being joined by an adhesive (column 3, lines 21-32). The characteristics of the composite construction of Barbieri '813 are not properly attributable to the single layer construction

of Benson '318. This composite construction also makes impossible the transparent properties required by Claim 40.

Therefore, Claim 40 is not anticipated by Benson '318, with or without the evidence of Barbieri, and furthermore it would not have been obvious to modify Benson's paper drinking cup to withstand said elevated temperature range. Withdrawal of the rejection of Claim 40 and reconsideration of the claim are respectfully requested.

Further, withdrawal of the rejection of Claims 3-7, 13, 18-19, 26-28, 32-33, 38-39, 41 and 43, which depend either directly or indirectly from claim 40, and reconsideration of the claims, are also respectfully requested.

Rejections Under 35 USC §103

Claims 2, 8-12, 15-16, 23 and 25 stand rejected under 35 USC §103(a) as being unpatentable over Benson '318 with Barbieri '813 in view of US Patent 4 187 768 to Suzuki. This rejection is respectfully traversed.

In order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As discussed above with respect to the rejection of Claim 40 under 35 USC §102, Benson '318 with Barbieri '813 does not disclose all of the limitations of Claim 40, and therefore Claim 40 is not anticipated by Benson '318. Suzuki '768 teaches a method of manufacture of a paper container, but does

not teach a temperature range for stability of the resulting container, an element missing from Benson '318 with respect to Claim 40. As a result, the combination of Benson '318 and Suzuki '768, even if made, fails to reach all of the limitations of Claim 40, and therefore also fails to reach the limitations of its depending claims. Withdrawal of the rejection of Claims 2, 8-12, 15-16, 23 and 25 and reconsideration of the claims are respectfully requested.

Claims 17, 20-22, 24 and 34-36 stand rejected under 35 USC §103(a) as being unpatentable over Benson '318 with Barbieri in view of Suzuki '768 and further in view of US Patent 6 210 766 to McLaughlin. This rejection is respectfully traversed.

As discussed above with respect to the rejection of Claim 40 under 35 USC §102, Benson '318 with Barbieri '813 does not disclose all of the limitations of Claim 40, and therefore Claim 40 is not anticipated by Benson '318. McLaughlin '766 teaches a holographic decorated tube package, but does not teach a temperature at which the tube remains dimensionally stable. Therefore, neither Suzuki '768 nor McLaughlin '766 teaches the elements missing from Benson '318 with respect to Claim 40, namely the temperature range within which the container is stable. As a result, the combination of Benson '318 and Suzuki '768, even if made, fails to reach all of the limitations of Claim 40, and therefore also fails to reach the limitations of its depending claims. Withdrawal of the rejection of Claims 17, 20-22, 24 and 34-36, and reconsideration of the claims, is respectfully requested.

Further, regarding the rejection of Claim 36, McLaughlin does not disclose that the tube wall is transparent, and that therefore the printing would form a control window. Therefore, the combination of Benson, Suzuki and McLaughlin further does not reach the limitations of Claim 36, and withdrawal of the rejection and reconsideration of the claim are respectfully requested.

Claim 29 stands rejected under 35 USC §103(a) as being unpatentable over Benson '318 with Barbieri '813 in view of US Patent 2 170 060 to Meyer. This rejection is respectfully traversed. Claim 29 calls for the material of the container to be transparent and colored. Meyer discloses forming a bead in the transparent material of a container and then inserting an ornamental cord or rope into the bead to be observed through the material. Neither Benson nor Meyer disclose a colored material, so that even if the combination were made, the invention as defined by Claim 29 would not result.

Further, as discussed above with respect to the rejection of Claim 40 under 35 USC §102, Benson '318 does not disclose all of the limitations of Claim 40, and therefore Claim 40 is not anticipated by Benson '318. Meyer '060 teaches a receptacle or box formed of cellophane or like transparent material, but does not teach a temperature at which the receptacle remains dimensionally stable. Therefore, Meyer '060 does not teach the elements missing from Benson '318 with respect to Claim 40, namely the temperature range in which the container remains stable. As a result, the combination of Benson '318 and Meyer '060, even if made, fails to reach all of the limitations of Claim 40 and its depending claims. Withdrawal of the rejection of Claim 29, and reconsideration of the claim, is respectfully requested.

Claims 30-31 stand rejected under 35 USC §103(a) as being unpatentable over Benson '318, with Barbieri '813, Suzuki '768 and McLaughlin '766 as applied to Claim 20 above, and further in view of US Patent 2 226 340 to Flood. This rejection is respectfully traversed.

Flood discloses a container having transparent portions associated with indicia such as gradations for measurement. The container is configured to be chemical resistant, and is intended to be inexpensive for disposal. Flood does not disclose a temperature or temperature range in which the container remains dimensionally stable.

As discussed above with respect to the rejection of Claim 40 under 35 USC §102, Benson '318, with Barbieri '813, does not disclose all of the limitations of Claim 40, and therefore Claim 40 is not anticipated by Benson '318. Further, Suzuki, McLaughlin and Flood do not teach the elements missing from Benson '318 with respect to Claim 40, namely the temperatures at which the container remains stable. As a result, the combination of Benson, Suzuki, McLaughlin and Flood, even if made, fails to reach all of the limitations of Claim 40 and its depending claims. Withdrawal of the rejection of Claims 30-31, and reconsideration of the claims, is respectfully requested.

Claim 37 stands rejected under 35 USC §103(a) as being unpatentable over Benson, Barbieri, Suzuki and McLaughlin as applied to Claim 20 above, and further in view of US Patent 2 689 424 to Clagett. This rejection is respectfully traversed.

Clagett discloses a dual indicia container, wherein a first of the indicia is color-matched to a fluid to be held in the container (e.g. white for milk), and the second of the indicia is color-matched to the translucent opposing wall of the container. The "front" wall of the container is transparent. When the container is full of the chosen fluid, the second indicia is highlighted against the fluid. When the container is emptied, the first indicia is highlighted due to the contrast in colors with the opposing wall, while the second indicia now blends in. Clagett does not disclose a temperature at which the container remains dimensionally stable.

As discussed above with respect to the rejection of Claim 40 under 35 USC §102, Benson '318 with Barbieri '813, does not disclose all of the limitations of Claim 40, and therefore Claim 40 is not anticipated by Benson '318. Suzuki, McLaughlin and Clagett do not teach the elements missing from Benson '318 with respect to Claim 40, namely the temperature range at which the container remains stable. As a result, the combination of Benson, Suzuki, McLaughlin and Clagett, even if

made, fails to reach all of the limitations of Claim 40 and its depending claims. Withdrawal of the rejection of Claim 37, and reconsideration of the claim, is respectfully requested.

Claim 42 stands rejected under 35 USC §103(a) as being unpatentable over Benson '318 with Barbieri '813 in view of US Patent 4 574 987 to Halligan et al. This rejection is respectfully traversed.

Halligan et al. discloses a container for "soft frozen comestibles," namely, ice cream cones. The container provides some insulation between a consumer's hand and the frozen product, which is disclosed as being stored in the 0°-15°F range. Halligan et al. does not disclose that the container is dimensionally stable from -50°C to +120°C.

As discussed above with respect to the rejection of Claim 40 under 35 USC §102, Benson '318, with Barbieri '813, does not disclose all of the limitations of Claim 40, and therefore Claim 40 is not anticipated by Benson '318. Halligan et al. '987 does not teach the elements missing from Benson '318 with respect to Claim 40, namely that the container is dimensionally stable from -50°C to +120°C. As a result, the combination of Benson '318 and Halligan et al. '987, even if made, fails to reach all of the limitations of Claim 40 and its depending claims. Withdrawal of the rejection of Claim 42, and reconsideration of the claim, is respectfully requested.

Conclusion

In light of the foregoing, the claims are considered in condition for allowance, and early Notice of Allowability is courteously solicited. If necessary to expedite further

prosecution of the application, the Examiner is invited to contact the Applicant's representatives listed below.

Respectfully submitted,



David G. Boutell

DGB/DJW/jas

FLYNN, THIEL, BOUTELL	Dale H. Thiel	Reg. No. 24 323
& TANIS, P.C.	David G. Boutell	Reg. No. 25 072
2026 Rambling Road	Terryence F. Chapman	Reg. No. 32 549
Kalamazoo, MI 49008-1631	Mark L. Maki	Reg. No. 36 589
Phone: (269) 381-1156	Liane L. Churney	Reg. No. 40 694
Fax: (269) 381-5465	Brian R. Tumm	Reg. No. 36 328
	Steven R. Thiel	Reg. No. 53 685
	Donald J. Wallace	Reg. No. 43 977
	Sidney B. Williams, Jr.	Reg. No. 24 949

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